

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

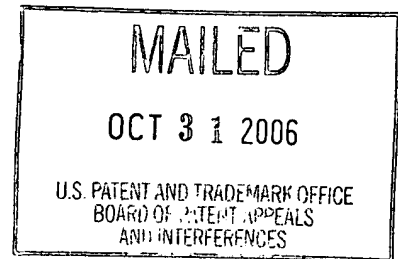
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte MARK S. KNIGHTON, DAVID S. AGABRA, and WILLIAM D. MCKINLEY

Appeal No. 2006-1541
Application No. 09/660,811

ON BRIEF



Before HAIRSTON, KRASS and MACDONALD, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request rehearing on the new ground of rejection under 35 U.S.C. § 112, first paragraph, entered in our decision of June 13, 2006, and on our affirmance of the examiner's rejection of claims 23-29 under 35 U.S.C. § 103.

With regard to the new ground of rejection under § 112, first paragraph, we found that there was an inadequate written description for the now-claimed "without a predefined relative position" because appellants never described the relative positions of the digitizer

and orientation fixture as being “without a predefined relative position” in the original disclosure.

Appellants assert that there, indeed, was adequate support for this claim limitation in the original disclosure. They point specifically to page 6, lines 5-8, of the specification for a recitation of “Acquiring the orientation fixture may permit, for example, any of automatic calibration of the digitizer, automatic determination of the relative position of the digitizer and orientation fixture, and fixture’s orientation or condition” (see page 2 of the request for rehearing of new ground for rejection). In particular, appellants assert that it is “non-sensical to suggest that it would be necessary to determine the relative position of the digitizer and orientation fixture if those relative positions were predefined” (page 2 of the request for rehearing of new ground for rejection).

We disagree. Merely because an automatic determination of the relative position of the digitizer and the orientation fixture may be made, does not necessarily mean that there was no predefined relative position between the digitizer and the orientation fixture. The two elements may have been set up in some predefined relative position initially, with the predefined relative position being randomly different each time the elements are oriented, and, in repositioning an object, the system makes an automatic determination of the relative position between the elements so as to use that measurement in the system calculation. The relative position may still be predefined but that information may not be given to the system, with the system automatically making its own determination of such relative position. That is, an automatic determination of the relative position of the digitizer and the orientation

fixture, and having a predefined relative position of the digitizer and the orientation fixture, are not, necessarily, mutually exclusive.

Thus, in our view, a mere disclosure of an automatic determination of such a relative position does not, necessarily, provide adequate support for the now-claimed orientation fixture and digitizer having “a predefined relative position.”

Accordingly, we are unpersuaded by appellants’ argument and maintain the rejection of claims 1-12 under 35 U.S.C. § 112, first paragraph.

Appellants take issue with our sustaining the rejection of claims 23-26 under 35 U.S.C. § 103 over Murphy. They contend that Murphy fails to teach preventing access to the image data by a local user until an authorization is received. Appellants point to column 15, lines 6-10, of Murphy for a teaching of permitting viewing of a stored frame without authorization, thus teaching away from preventing access.

We are unpersuaded of any error in our reasoning re claims 23-26, as set forth at pages 14-15 of our decision, as appellants have not shown what is the alleged error. As indicated at page 14 of our decision, and contrary to appellants’ allegation, Murphy suggests, at column 15, lines 6 et seq. that access to image data by a user is prevented until authorization is received.

Appellants next argue that we erroneously sustained the rejection of claims 27-29 under 35 U.S.C. § 103 because we failed to address one aspect of appellants’ argument. Appellants argue that the combination of Truc, Migdal and Pito would not result in the claimed invention. In particular, appellants argue that the examiner merely pointed to a

section of the background of the invention in Truc wherein it was indicated that it is desirable to rescan certain images at higher resolution, but that contextually, in Truc, it appears that the examination of the digital representation of the images is conducted by a user and not as a result of any data analyzer, as claimed. Thus, appellants conclude that the absence of any data analyzer performing the functionality in claims 27 and 29 “could be fatal to the examiner’s rejection” (page 3 of the request for rehearing partial affirmance of examiner’s rejections).

Moreover, appellants argue that the data analyzer of claim 29 conducts a rescan using a different capture method, such as stereoscopy, profilometry, etc. and since these different capture methods do not apply to a two-dimensional medium, Truc offers nothing in this connection, and neither Pito nor Migdal discloses recapturing using alternative capture methods.

We disagree.

Truc was employed for its teaching of the desirability to rescan certain images at higher resolution. It matters not that Truc, alone, might not perform this scan as a result of a data analyzer as the rejection is based on what a combination of references would have suggested to the skilled artisan. Moreover, we are unpersuaded by appellants’ argument scanning with specific different capture methods, since it is unclear just what specific claim language appellants rely on for this argument.

We have considered each and every argument of appellants with regard to the new ground of rejection under 35 U.S.C. § 112, first paragraph, and with regard to the affirmance

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of the rejection of claims 23-29 under 35 U.S.C. § 103, and while we grant appellants' request to the extent that we have reconsidered our position, we deny appellants' request for rehearing to the extent of making any changes to our decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

DENIED


KENNETH HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

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